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October 16, 2006
Date of Signature

PATENT
Case No. AUS920010923US1
(9000/81)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:)

ANTHONY E. MARTINEZ, ET AL.)

Serial No.: 09/981,877)

Filed: OCTOBER 18, 2001)

Title: METHOD OF PREVIEWING A)
GRAPHICAL IMAGE CORRESPONDING)
TO AN ICON IN A CLIPBOARD)

Examiner: BONSHOCK, D. G.

Group Art Unit: 2173

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22202-1450

Dear Sir:

Appellants respectfully present their Brief on Appeal as follows:

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1. **REAL PARTY IN INTEREST**

The real party in interest is assignee INTERNATIONAL BUSINESS MACHINES CORPORATION, a corporation organized and existing under the laws of the State of New York, USA and located at New Orchard Road, Armonk, New York 10504, USA

2. **RELATED APPEALS AND INTERFERENCES**

Appellant and the undersigned attorneys are not aware of any appeals or any interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS

Claims 1 -16 are currently pending in the application and stand finally rejected under 35 U.S.C. §102(a) as anticipated by “MS Word.” All claims are on appeal. See, the Appendix.

4. STATUS OF AMENDMENTS

All previously filed amendments have been entered in the application.

5. **SUMMARY OF CLAIMED SUBJECT MATTER**

Independent Claim 1:

The invention provides a method of previewing a graphical image 18 corresponding to an icon 16 in a clipboard (p.4, lines 12-25). The method includes receiving an icon preview instruction (p. 4, lines 17-20) from a user and displaying the graphical image 18 associated with the icon 18 in response to the icon preview instruction.

Independent Claim 4:

A method of displaying a clipboard includes receiving a paste command (p.2, line 26, p. 4, lines 18-20) and determining whether a plurality of objects are stored within the clipboard in response to the paste command (p. 4, lines 18-20). The method further includes displaying the clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard (p. 4, lines 18-21).

Independent Claim 9:

The invention further provides a computer usable medium including a program for previewing a graphical image corresponding to an icon in a clipboard. The medium includes computer readable code for receiving an icon preview instruction from a user (p. 4, lines 17-20), and computer readable code for displaying the graphical image associated with the icon in response to the icon preview instruction (p. 4, lines 17-20).

Independent Claim 12:

Additionally, the invention provides a computer usable medium including a program for displaying a clipboard. The program includes computer readable code for receiving a paste command (p. 4, lines 18-20), computer readable code for determining whether a plurality of objects are stored within the clipboard in response to the paste command (p. 4, lines 18-20), and computer readable code for displaying the clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard (p. 4, lines 18-20).

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Does the display of a text sample, the text sample consisting of ASCII characters such that the image of the text sample differs in appearance from the text, in response to a mouse action as disclosed by “MSWord” anticipate under 35 U.S.C. §102(a) displaying a “graphical image associated with the icon in response to the icon preview instruction” as claimed in claim 1?

7. **ARGUMENTS**

A. “MSWord” does not disclose each and every element of claim 1

The rejection of claims 1-16 as anticipated under 35 U.S.C §102(a) over MSWord is traversed. In order to maintain this §102(a) rejection, each and every element of the claimed invention must be disclosed in as great detail by the reference. Because the reference does not disclose each and every element, this rejection must fall.

As the “reference” does not disclose “displaying the graphical image associated with the icon in response to the icon preview instruction,” as claimed in claim 1, the §102(a) rejection cannot stand.

At most, the “reference” discloses that a *text* sample of the clipboard icon is disclosed upon a mouse action, and not the display of a *graphical* image. See, MS Figure 2. Those of ordinary skill in the art readily recognize the differences between text and graphics. Indeed, an example of the difference is apparent from an inspection of MS Figure 2. Those of ordinary skill in the art are well acquainted with ASCII characters and fonts – ASCII characters serve to allow a computer to recognize characters of different fonts as the same character. Thus, for example “The cat ran up the hill” is rendered in Times New Roman font (in MS Figure 2), but the computer recognizes the ASCII characters in that text string as being capable of rendering in multiple fonts. “The cat ran up the hill” *could* also be rendered in Arial font - “The cat ran up the hill”, Bookman Old Style - “The cat ran up the hill” or a multitude of other well-recognized fonts. In MS Figure 2, the allegedly anticipatory illustration illustrates the text string in different fonts, making apparent to one of ordinary skill in the art that the computer is using a text string, rather than a graphical image. Were the Examiner’s computer using a graphical image, the fonts on the two samples, (i.e. on the screen and on the popup) would be identical. Because the fonts are different (the onscreen version uses a serif font, while the pop-up version is rendered in a sans-serif font), those of

ordinary skill in the art will recognize that the computer is using ASCII characters rather than graphical images.

Additionally, MS Figure 9 not only does not disclose the claimed elements, MS Figure 9 unequivocally teaches away from displaying a graphical image – “If the item is a drawing object or picture, or an item that doesn’t contain text, Microsoft Word displays a label “Picture 2,” which indicates the order in which the item was copied.” Such a statement clearly indicates not only that the “reference” does not teach displaying “the graphical image associated with the icon,” but the statement directly teaches away from doing such an action. Furthermore, MS Figure 9 teaches and discloses that the program can only preview “50 characters of text.”

The Examiner’s comments in paragraph 17 of the August 26, 2004 office action provide support for Appellant’s position. The Examiner alleges that “text stored here are *represented* as a ‘W’ located on a page, in contrast pictures are *represented* as an icon...” (emphasis added). However, the claim requires “displaying the graphical image associated with the icon in response to the icon preview instruction,” and not *representing* the picture as an icon. Thus, the claim requires “displaying the graphical image associated with the icon in response to the icon preview instruction” rather than displaying an icon associated with the graphical image.

The Examiner’s argument that “MSWord” discloses a graphical image associated with an image on the clipboard is disingenuous. Claim 1 requires displaying the graphical image associated with the icon in response to the icon preview instruction and not the “image on the clipboard.” See, paragraph 19 of the August 26, 2004 office action.

Appellants further note that the “reference” does not teach or suggest the desirability of using a graphical icon as a preview. In addition, none of the other cited references disclose the claimed invention.

Because the “reference” and other cited references do not disclose each and every element of claim 1, Appellants request the withdrawal of the §102(a) rejections of these claims, and claims 2-3 and 10-11 depending therefrom.

B. “MSWord” is not a reference under 35 U.S.C §102(a) and cannot support an anticipation rejection

Appellants traverse the rejection on the grounds that “MSWord” is not prior art, per MPEP §2128. Since “MSWord” does not qualify as prior art, it cannot be used to support a rejection, and the rejection must be withdrawn.

First, the Examiner has not stated, nor even alleged, that the documents were ever publicly accessible, much less accessible to persons concerned with the art to which the documents relate. The Examiner admits that the documents are screenshots of the Examiner’s own computer taken April 22, 2004. Thus, the earliest these documents could possibly have been publicly accessible is 2.5 years after the filing of this application.

The MPEP is quite clear that a reference is a “printed publication” as required by §102(a) only “upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that person interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *See* MPEP 2128, *In re Wyer*, 655 F.2d 221 (CCPA 1981). The Examiner does not even allege that a single other person, much less one of ordinary skill in the art, has access to his personal computer at the PTO.

The Examiner’s inclusion of “MS Figure 8” appears targeted to show that the program was available prior to October 18, 2001. However, the copyright dates of a computer program are irrelevant to its status as a printed publication. Further, the screenshot illustrating the copyright dates does not show the allegedly anticipatory method in action, and therefore calls the anticipatory nature of the alleged reference into question.

While the Examiner may argue that he need not prove anyone actually looked at the document, he must show both that someone could have (i.e. see MPEP 2128.01) and the date that the publication is available as a reference. The Examiner has failed on both counts here. First, the Examiner has not alleged that his computer was available to the public prior to October 18, 2001. Second, the Examiner has not alleged any dates that the publications were available to the public.

The Examiner's argument that "cases in which screen shots were used to illustrate operational characteristics of software applications have been known be deemed [sic] acceptable by the courts" is irrelevant and without citation. Whether a screen shot illustrates operational characteristics has nothing to do with proof of anticipation. The elements of a "reference" are clearly delineated, and the Examiner cannot support the status of "MSWord" as a §102(a) reference. As outlined above, even if "MSWord" is properly a reference, "MSWord" does not disclose the claimed elements.

Thus, for at least the ground that the Examiner's "reference" is not prior art, Appellants request withdrawal of the rejections to claims 1-16.

CONCLUSION

The Appellants respectfully submit that claims 1-16 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **October 16, 2006**

Respectfully submitted,
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9. CLAIMS APPENDIX

1. A method of previewing a graphical image corresponding to an icon in a clipboard, comprising:
 - receiving an icon preview instruction from a user; and
 - displaying the graphical image associated with the icon in response to the icon preview instruction.
2. The method of claim 1 wherein receiving an icon preview instruction comprises determining whether a display position indicator is positioned over the icon displayed in the clipboard for a predetermined time period.
3. The method of claim 1 wherein displaying the graphical image comprises displaying a reduced image of the graphical image.
4. A method of displaying a clipboard comprising:
 - receiving a paste command;
 - determining whether a plurality of objects are stored within the clipboard in response to the paste command; and
 - displaying the clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard.
5. The method of claim 4 wherein displaying the clipboard adjacent the display position indicator comprises positioning an icon associated with a last pasted object adjacent the display position indicator.

6. The method of claim 4 further comprising:
hiding the clipboard in response to selecting an icon corresponding to an image stored on a clipboard.
7. The method of claim 4 further comprising:
hiding the clipboard in response to moving position indicator so that the position indicator is not adjacent to the clipboard.
8. The method of claim 4 further comprising:
hiding the clipboard in response to selecting a close icon on the clipboard.
9. Computer usable medium including a program for previewing a graphical image corresponding to an icon in a clipboard, comprising:
computer readable code for receiving an icon preview instruction from a user;
and
computer readable code for displaying the graphical image associated with the icon in response to the icon preview instruction.
10. The computer usable medium of claim 9 wherein receiving an icon preview instruction comprises determining whether a display position indicator is positioned over the icon displayed in the clipboard for a predetermined time period.
11. The computer usable medium of claim 9 wherein displaying the graphical image comprises displaying a reduced image of the graphical image.

12. Computer usable medium including a program for displaying a clipboard comprising:

computer readable code for receiving a paste command;
computer readable code for determining whether a plurality of objects are stored within the clipboard in response to the paste command; and
computer readable code for displaying the clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard.

13. The computer usable medium of claim 12 wherein displaying the clipboard adjacent the display position indicator comprises positioning an icon associated with a last pasted paste-able object adjacent the display position indicator.

14. The computer usable medium of claim 12 further comprising:
hiding the clipboard in response to selecting an icon corresponding to an image stored on a clipboard.

15. The computer usable medium of claim 12 further comprising:
hiding the clipboard in response to moving position indicator so that the position indicator is not adjacent to the clipboard.

16. The computer usable medium of claim 12 further comprising:
hiding the clipboard in response to selecting a close icon on the clipboard.

10 EVIDENCE APPENDIX

Appellants entered no evidence pursuant to §1.130, 1.131 or 1.132, and the Examiner entered no evidence that was relied upon by Appellants.

11. RELATED PROCEEDINGS APPENDIX

There are no copies of related decisions or proceedings.